



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/092,696	06/05/1998	SHIRLEY ANN BARCELON	5468-07-LAV	6388

7590

09/19/2006

WATOV & KIPNES, P.C.
P.O. BOX 247
PRINCETON JUNCTION, NJ 08550

EXAMINER

WONG, LESLIE A

ART UNIT	PAPER NUMBER
----------	--------------

1761

DATE MAILED: 09/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/092,696

Applicant(s)

BARCELON ET AL.

Examiner

Leslie Wong

Art Unit

1761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on August 28, 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9, 11, 13, 14, 16 and 18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9, 11, 13, 14, 16 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1761

It is noted that claims 12 and 17 were previously cancelled in an amendment submitted August 27, 2001.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Upon further review, Claims 9, 11, 13, 14, 16, and 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant does not teach "consisting essentially of." Specifically, Applicant does not teach what is excluded and/or included by this language or what does and does not materially affect the invention.

Claims 9, 11, 13, 14, 16, and 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant does not teach the exclusion of eucalyptus. The exclusion of eucalyptus is considered new matter by deletion (see MPEP 706.03(o)).

Art Unit: 1761

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Record et al (US Patent No. 5,372,824) for the reasons set forth in rejecting the claims in the last Office action.

Record et al disclose the combination of flavor and N-ethyl-p-menthane-3-carboxamide in the amounts claimed for use in chewing gums (see entire patent).

The claims differ as to enhancement and the specific flavors.

It would have been obvious to a person of ordinary skill in the art, at the time the invention was made to use any flavor in that of Record et al because the choice of flavor is seen to be no more than a matter of choice and well-within the skill of the art.

Applicant attaches no criticality to the flavor and discloses fruit, herbal, and spice flavors and specifically states that "(o)ther flavors known to those skilled in the art may also be enhance" (see page 4, second full paragraph). Enhancement would be obvious to that of Record et al as the same components are used.

Applicant does not exclude additional components. Applicant attaches no criticality to the flavor and discloses fruit, herbal, and spice flavors and specifically states that "(o)ther flavors known to those skilled in the art may also be enhance" (see page 4, second full paragraph).

Claims 9, 11, 13, 14, 16, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cherukuri et al (US Patent No. 5,009,893) for the reasons set forth in rejecting the claims in the last Office action.

Cherukuri et al disclose the combination of a flavor (e.g. mint and cherry) and N-ethyl-p-menthane-3-carboxamide in the amounts claimed for use in chewing gums and confections (see entire patent).

The claims differ as to enhancement and the specific flavors.

It would have been obvious to a person of ordinary skill in the art, at the time the invention was made, to use any flavor in that of Cherukuri et al because the choice of flavor is seen to be no more than a matter of choice and well-within the skill of the art. Applicant attaches no criticality to the flavor and discloses fruit, herbal, and spice flavors and specifically states that “(o)ther flavors known to those skilled in the art may also be enhance” (see page 4, second full paragraph). Enhancement would be obvious to that of Cherukuri et al as the same components are used.

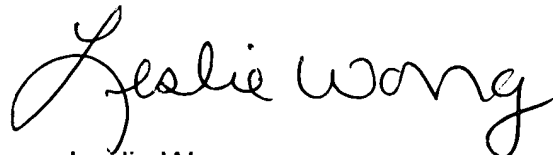
Cherukuri et al clearly teach the combination of a flavor (e.g. cherry) and N-ethyl-p-menthane-3-carboxamide in the amounts claimed for use in chewing gums and confections (see entire patent). Table V shows examples that exclude menthol. It is further noted Table V merely teaches that which is known in the art. Certainly, one of ordinary skill in the art would also consider comparative examples when considering a reference.

Art Unit: 1761

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leslie Wong whose telephone number is 571-272-1411. The examiner can normally be reached on Tuesday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink that reads "Leslie Wong". The signature is fluid and cursive, with the first letter of "Leslie" being a large, stylized capital "L".

Leslie Wong
Primary Examiner
Art Unit 1761

LAW
September 14, 2006